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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/018,981	12/18/2001	Hao Yuan	13774-002001	2606

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EXAMINER

OH, SIMON J

ART UNIT

PAPER NUMBER

1615

DATE MAILED: 08/08/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/018,981

Applicant(s)

YUAN, HAO

Examiner

Simon J. Oh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☒ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_ 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Priority***

1. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in China on June 18, 1999. It is noted, however, that applicant has not filed a certified copy of the 99109147.7 application as required by 35 U.S.C. 119(b).

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, the phrase “[a] kind of extract” renders the claim indefinite because it is unclear because the claim includes elements not actually disclosed (those encompassed by “[a] kind of extract”), thereby rendering the scope of the claim unascertainable. See MPEP § 2173.05.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 3-5, 7, 12, and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by the Liu *et al.* article.

The Liu *et al.* article discloses the existence of the *Shengmai Chenggu* tablet, which consists of the leaves of *Cajanus cajan* (L.) Millsp; the tablet is disclosed to be effective for treating necrosis of the femoral head. The leaves of *Cajanus cajan* (L.) Millsp are disclosed as being effective in treating injury, burn infection, sores, and jaundice; the leaves are also reported to possess anti-septic and anti-inflammation properties (See Page 7).

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Liu *et al.* article in view of the Yuan document (Chinese Patent Document No. CN 1174052).

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

The Liu *et al.* article discloses the existence of the *Shengmai Chenggu* tablet, which consists of the leaves of *Cajanus cajan* (L.) Millsp; the tablet is disclosed to be effective for treating necrosis of the femoral head. The leaves of *Cajanus cajan* (L.) Millsp are disclosed as being effective in treating injury, burn infection, sores, and jaundice; the leaves are also reported to possess anti-septic and anti-inflammation properties (See Page 7). In addition, a process for preparing an extract and a powder from the leaves of *Cajanus cajan* (L.) Millsp is disclosed. The process involves taking a batch of the leaves and cutting into pieces. Water is added in amount that is 10 times that of the leaves. The mixture is heated and boiled 3 times for a duration of 1 hour each time. The filtered solution is concentrated in a vacuum, and the remaining paste is dried and then pulverized into powder (See Page 8, Section 2.1.1). This process is then optimized so that the mixture of leaves and water is boiled 3 times for a duration of 1.5 hours each time (See Page 7, Abstract; and Page 9, Section 4).

The Liu *et al.* article does not disclose any specific settings for process variables. The article also does not disclose a method of treatment comprising the administration of leaves of *Cajanus cajan* (L.) Millsp or an extract thereof for ameliorating of hemorheological index, reinforcing immunological functions, treating angina of coronary heart disease, treating fracture, treating cerebral infarction, treating the infected surface of the wound of an open fracture, or treating osteoporosis.

The Yuan document discloses the use of the leaves of *Cajanus cajan* (L.) Millsp in a medical preparation for curing ischemic necrosis of the femoral head. This medical preparation is reported to prevent microcirculation, promoting blood vessel regeneration, absorbing necrotic bone, and regenerating new bone (See Abstract).

It would be obvious to one of ordinary skill in the art to combine the teachings of Liu *et al.* and Yuan into the objects of the present invention. The Liu *et al.* article teaches the basic method of preparing an extract of the leaves of *Cajanus cajan* (L.) Millsp, as well as the therapeutic properties of such a preparation. The Yuan document also teaches a medical preparation of *Cajanus cajan* (L.) Millsp, as well as disclosing additional therapeutic properties of such a composition. One of ordinary skill in the art to combine the references because as stated in *In re Kerkhoven*, 205 USPQ 1069, 1072 (CCPA- 1980), “It is prima facie obvious to combine two compositions, each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition which is to be used for the very same purpose.” As this court explained in *Crockett*, 126 USPQ 186, 188 (CCPA- 1960), the idea of combining them flows logically from their having been individually taught in the prior art. Regarding claim limitations drawn to specific settings for process variables, it is the position of the examiner what where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation. *In re Aller*, 220 F.2d 454 105 USPQ 233, 235 (CCPA 1955). Regarding claim limitations drawn to treatments for specific diseases or conditions, it is the position of the examiner that the general therapeutic properties taught by the prior art obviates these claim limitations. The prior art establishes certain generic features of preparations of *Cajanus cajan* (L.) Millsp, including the absorption of necrotic tissue, promotion of bone health, promotion of blood vessel health, antiseptic properties, wound and sore healing properties, and anti-inflammatory properties. The discovery of treatments for specific conditions laid out by the applicant would be obvious for one of ordinary skill in the art through routine experimentation, in light of the general therapeutic properties of *Cajanus cajan*

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(L.) Millsp disclosed by the prior art. Thus, the claimed invention as a whole is *prima facie* obvious.

### *Correspondence*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Simon J. Oh whose telephone number is (703) 305-3265. The examiner can normally be reached on M-F 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K Page can be reached on (703) 308-2927. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3014 for regular communications and (703) 305-3014 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

Simon J. Oh  
Patent Examiner  
AU 1615

sjoh  
August 1, 2002

  
THURMAN K. PAGE  
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